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CERTIFICATE

Supreme Court of the United States

OCTOBER TERM, 1935

No. 590

THE MANTLE LAMP COMPANY OF AMERICA

vs.

ALUMINUM PRODUCTS COMPANY.

ON CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

FILED NOVEMBER 16, 1935.

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IN THE

United States Circuit Court of Appeals

FOR THE SEVENTH CIRCUIT.

No. 5412. OCTOBER TERM AND SESSION, 1935.

THE MANTLE LAMP COMPANY OF AMERICA, a corporation,
Appellant,
vs.
ALUMINUM PRODUCTS COMPANY, a corporation,
Appellee.

Appeal from the District Court of the United States for the Northern District of Illinois, Eastern Division.

Upon hearing and consideration of this appeal there have arisen certain questions of law whereon this Court is in doubt and desires the instruction and advice of the Supreme Court of the United States.

The relevant facts out of which such legal questions grow are:

United States Letters Patent No. 1,435,199, for a heat-insulated receptacle, were issued November 14, 1922, to the Mantle Lamp Company of America, the appellant, assignee of Lewis Van Deventer Blair, upon Blair's application therefor filed October 29, 1919.

On November 21, 1932, appellant brought suit under said patent in the District Court of the United States for the Northern District of Illinois, Eastern Division, against the appellee herein. The bill of complaint charged appellee with infringement of the said Blair patent, and demanded relief by injunction and accounting. Appellee answered setting up, *inter alia,* prior suits by appellant in the same circuit wherein claims of the Blair patent had been found and decreed invalid, and that

"9. The defendant further answering the bill of complaint avers that no disclaimer as required by the stat-

utes of the United States has been made and/or filed in the United States Patent Office, in connection with Blair Patent 1,435,199, as to claims 1, 4, 5, 6, 7, 10, 11, 12, 13, 14, 17, 18, 21, 22, 23 and 24 thereof which were held invalid by the United States Circuit Court of Appeals for the Seventh Circuit on May 28, 1927, in the case of *Macomb Mfg. Co.* v. *The Mantle Lamp Company of America,* Docket No. 3812, referred to in Section A of paragraph 8 hereof, and that because no disclaimer has been filed as aforesaid Blair Patent No. 1,435,199 is entirely invalid."

Upon hearing of the cause the District Court held and decreed claims 1, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 17, 18, 21, 22, 23 and 24, whereon appellant relied, to be invalid for various reasons, among them for neglect to file within reasonable time disclaimers of the said claims of this patent which had been, in prior suits, held to be invalid by the United States Circuit Court of Appeals for the Seventh Judicial Circuit,[1] and decreed dismissal of the bill for want of equity, from which decree the pending appeal was taken.

On July 8, 1924, this appellant brought suit against Macomb Manufacturing Company in the District Court of the United States for the Southern District of Illinois, charging that defendant with infringement of certain claims of the said Blair patent; and upon the hearing of that cause the court found the claims there in issue, viz., claims 1, 4, 5, 6, 7, 10, 11, 12, 13, 14, 17, 18, 21, 22, 23 and 24, to be valid and infringed, and entered a decree accordingly, from which decree an appeal was prayed and allowed to the United States Circuit Court of Appeals for the Seventh Judicial Circuit.

In a suit brought October 2, 1924, in the District Court of the United States for the Northern District of Illinois, Eastern Division, the appellant herein was a party, and the said

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1 Among the District Court's findings of fact are:

"37. The present suit was commenced on November 21, 1932, or over five years after the judgments rendered in the Macomb and Monarch suits.

"38. No disclaimer has been filed to date, a period of over six years, by The Mantle Lamp Co. of America as to any of the claims held to be invalid in the Macomb and Monarch suits.

"39. This delay of over five years in instituting this suit and six years to date in filing disclaimers to the claims held invalid in the Macomb and Monarch suits is unreasonable within the meaning of the disclaimer statutes, Sections 65 and 71, Title 35 U. S. C. A."

Among the District Court's conclusions of law is:

"6. Each of the claims of the Blair Patent is invalid for unreasonable delay and neglect in filing disclaimers to invalid claims."

Blair patent became involved by way of a counterclaim. The said District Court held the claims of the Blair patent there in suit, to wit, claims 1, 3, 4, 5, 6, 7, 10, 11, 12, 13, 14, 17, 18, 21, 22, 23 and 24, were valid and infringed and decreed accordingly, from which decree an appeal was prayed and allowed to the United States Circuit Court of Appeals for the Seventh Judicial Circuit.

The two appeals last above referred to were co-pending in the United States Circuit Court of Appeals for the Seventh Judicial Circuit and were there heard together; and on May 28, 1927, the Court filed opinions in both of the appeals holding the enumerated claims of the said Blair patent therein respectively involved to be invalid, and adjudging and directing that the decrees therein be reversed, and ordering dismissal, for want of equity, of the bill of complaint in the first of those appeals and dismissal of the counterclaim in the second. 22 F. (2d) 93 and 95.

No petition for certiorari was filed in either cause, and on December 5, 1927, the said Circuit Court of Appeals issued mandates to the respective District Courts in the said causes, whereupon the bill of complaint in the one and the counterclaim in the other were promptly thereafter dismissed, and these causes, so far as they involved the said Blair patent, were finally concluded.

On July 28, 1924, appellant brought a suit on said Blair patent in the District Court of the United States for the Western District of Missouri against Cutino Company, a customer or jobber of Monarch Company, Incorporated, and on January 3, 1928, a bill was brought in the District Court of the United States for the Northern District of Illinois, Eastern Division, by Monarch Company, Incorporated, et al., to restrain the prosecution of the said suit in Missouri. A motion for temporary injunction having been denied, an appeal was taken to the United States Circuit Court of Appeals for the Seventh Judicial Circuit, in which Court, on October 2, 1928, the decree of the District Court was reversed and a temporary injunction was ordered restraining appellant from prosecuting any suit against any customers of the Monarch Company, Incorporated.

On September 12, 1928, appellant brought suit for infringement of said Blair patent against the George H. Bowman Company in the District Court of the United States for the

Northern District of Ohio, and upon the hearing of said cause the claims there in issue, to wit, 1, 3, 4, 5, 6, 7, 9, 10, 11, 12, 13, 14, 17, 18, 21, 22, 23 and 24, were held invalid and the bill was ordered dismissed. An appeal was taken to the United States Circuit Court of Appeals for the Sixth Judicial Circuit, where, in an opinion filed November 3, 1931 (53 F. (2d) 441), that Court reversed the District Court as to claim 1 of the Blair patent, finding it to be valid and infringed, without prejudice to the remaining claims in suit. This appellant petitioned the Supreme Court of the United States for writ of certiorari, based upon conflict of opinion and decision respecting said patent between the two Circuit Courts of Appeals, which petition was denied March 14, 1932. 285 U. S. 545.

The questions concerning which this Court desires the instruction and advice of the Supreme Court are:

1. Where certain but not all of the claims of a patent are in suit, and all of the claims in suit are held and decreed to be invalid pursuant to a finding and judgment to that effect of the Circuit Court of Appeals of the circuit, may the owner of the patent maintain a suit afterward brought thereon in the same judicial circuit as that in which the first cause was decided, and against a different defendant not involved in the first suit—the second suit being based on the claims held in the prior suit to be invalid and on other claims of the same patent not previously adjudicated—where the owner of the patent wholly failed and omitted to file any disclaimer of the claims held in the first suit to be invalid, and where, between entry of decree of invalidity of the claims in the first suit and the bringing of the second suit in the same circuit, reasonable time had elapsed for filing such disclaimer?

2. If question 1 is answered in the affirmative, does the intervention of a period of approximately five years between the final judgment in the first suit and the institution in the same circuit of the second suit constitute delay so unreasonable as to bar the second suit for want of disclaimer of the claims which had been held to be invalid?

3. If question 2 is answered affirmatively, may the institution or pendency of other suits in another judicial circuit or circuits after entry of final decree in the first suit, based on claims of the patent so held invalid and on other claims thereof not previously adjudicated to be invalid, excuse the

failure to file disclaimer of the claims held invalid prior to instituting the later suit in the same circuit?

The Clerk of this Court is directed to transmit to the United States Supreme Court a certified copy hereof.

EVAN A. EVANS,
WILLIAM M. SPARKS,
SAMUEL ALSCHULER,
United States Circuit Judges before whom the appeal herein was heard and is pending in the United States Circuit Court of Appeals for the Seventh Judicial Circuit.

Chicago, Illinois,
October 30, 1935.

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No. 590

THE MANTLE LAMP COMPANY OF AMERICA,

vs.

ALUMINUM PRODUCTS COMPANY.

ON CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

BRIEF OF APPELLANT.

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